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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,805	12/18/2001	Tetsuo Oyama	MTS-3299US	5979

7590 07/25/2005

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EXAMINER	
BILGRAMI, ASGHAR H	

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/025,805	OYAMA, TETSUO	
	Examiner	Art Unit	
	Asghar Bilgrami	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. In view of the amendment made to claim 1 by the Applicant the Examiner has withdrawn the claim objection.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "E-mail address Change Notification System".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6,427,164 B1) and Nielson (U.S. 6,405,234 B1).

5. As per claims 1, 10, 21, 19, 20, 22, 23, 24, 25, 26, 27 & 28 Reilly disclosed an address change notification deputization service server comprising, wherein when a first provider server in which a first mail address of a client is set receives an e-mail that is sent to said first mail address this e-mail is transferred to a second provider server in which a second mail address of said client is set and, then, when said second provider server receives an e-mail transferred from said first provider server (Reilly, col.4, lines 44-62). However Reilly did not explicitly disclose that said address change notification deputization service server receives this transfer, and wherein the path of the e-mail transferred from said second provider server is checked and in the

case that this e-mail is received by said second provider server after transferred from said first provider server, said address change notification deputization service server makes a notification to the effect that the e-mail address of said client is said second mail address to the sender of this e-mail.
In the same field of endeavor Nielson disclosed that said address change notification deputization service server receives this transfer, and wherein the path of the e-mail transferred from said second provider server is checked and in the case that this e-mail is received by said second provider server after transferred from said first provider server, said address change notification deputization service server makes a notification to the effect that the e-mail address of said client is said second mail address to the sender of this e-mail (Nielsen, col.2, lines 58-67). It would have been obvious to one in the ordinary skill in the art at the time the invention was made to combine address change server having old to new address change capability and the ability to send the new address to the sender as taught by Nielsen with address change notification deputization service server described by Reilly to facilitate the sender in discovering the new address of a recipient that he/she is trying to reach from the old address and in turn making the address discovering process more robust for the user.

6. As per claims 2 & 11 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein said address change notification deputization service server is provided with an e-mail header analyzing means of extracting and analyzing the e-mail header from said transferred e-mail, and wherein said e-mail header analyzing means checks said path by analyzing the e-mail header of said e-mail (Nielsen, col.7, lines 26-35).

7. As per claims 3 & 12 The e-mail address change notification deputization system according to Claim 1, wherein a terminal of said client receives said e-mail from said second provider server, and the e-mail received by the terminal of said client has the same contents as of the e-mail transferred to said address change notification deputization service server (Reilly, col.4, lines 44-62).

8. As per claims 4 & 13 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein said address change notification deputization service server makes a notification, to said client, of path information whether said e-mail is sent via said first provider server or directly to said second provider server (Reilly, col.8, lines 7-30).

9. As per claims 5 & 14 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 4, wherein said path information includes information as a result of classifying a plurality of said e-mails for the paths and of statistically processing the classified e-mails (Reilly, col.8, lines 7-30).

10. As per claims 6 & 15 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein said address change notification deputization service server has e-mail addresses of a predetermined one or a plurality of senders that send an e-mail to said client, and wherein the operation of making said notification is stopped when all the e-mails sent from the e-mail addresses of said senders have been confirmed to be received by said second provider server without passing through said first provider server (Reilly, col.6, lines 66-67 & col.7, lines 1-26).

11. As per claims 7 & 16 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein said address change notification deputization service server simultaneously sends a program for rewriting said first e-mail addresses of said client that is inscribed in an address book of the receivers of said notification to said second mail addresses at the time when carrying out the operation of making said notification (Reilly, col.9, lines 34-58).

12. As per claims 8 & 17 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein in the case that a sender of an e-mail to said client is an information distributor, said sender make a contract with the manager of said address change notification deputization service server such that said information distributor spontaneously switches said first e-mail addresses for said client to said second e-mail addresses in the case that said information distributor receives said notification from said address change notification deputization service server (Neilson, col.4, lines 59-67 & col.5, lines 1-21).

13. As per claims 9 & 18 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 8, wherein a terminal of said information distributor is provided with a means of switching the addresses of said client to the second e-mail addresses in the case that said notification is received from the manager of said address change notification deputization service server who has made said contract (Neilson, col.6, lines 56-67 & col.7, lines 1-15).

14. As per claims 29, 30 & 31 Reilly-Nielsen disclosed a medium that holds a program for allowing a computer to function as the entirety of, or a part of, the first provider server in which the first e-mail address of the client is set, the second provider server in which the second e-mail address of said client is set and the address change notification deputization service server in the e-mail address change notification deputization system according to Claim 1, wherein the medium can be processed by a computer (Reilly, col.4, lines 44-62).

Response to Arguments

15. Applicant's arguments filed on May 5, 2005 have been fully considered but they are not persuasive.

When reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

16. The applicant argued "Neither Reilly nor Nielson disclose, teach or suggest a second provider server that transfers an e-mail that has been transferred from a first provider server to an address change notification deputization service server."

As to applicants argument Reilly disclosed that the new e-mail address can be supplied to the "forwarding listserver" (notification deputization service server) by any other entity, such as the user's new ISP (second server) after it receives from the user from their previous e-mail address (first server) (col.2, lines 63-67 & col.3, lines 1-26).

17. The applicant argued neither Reilly nor Nielson disclose, teach or suggest an address change notification deputization service that checks the path of an e-mail that is received by a second provider server and notifies the sender of the e-mail if the e-mail is received by the second provider server after being transferred by a first provider server".

As to applicant's arguments Reilly disclosed that the "forwarding listserver" includes the forwarding information, which can include old address, new address and other form of information and then transferred. It would have been obvious to include to path information that the e-mail took in the forwarding information. Also Reilly disclosed that the sender is notified once the e-mail is sent to the new address.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on M-F, 8:00-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Asghar Bilgrami
Examiner
Art Unit 2143

AB

WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER